

## **REMARKS**

### **Status of the Claims**

Claims 36-84 are pending in this application.

Claims 36-50, 52-57, 71, 73-77 and 84 are rejected.

Claims 51, 72 and 85 are objected to.

Claims 58-70 and 78-83 are allowed.

Claim 86 has been added as new.

Claims 36, 41, 46, 57, 73 and 84 have been amended. Support for these amendments can be found throughout the specification, claims, and drawings, as originally filed.

### **Rejection of Claims 36-50, 52-57, 71, 73-77 and 84 under 35 U.S.C. § 103**

Applicant notes that Applicant's representative contacted Examiner Wood requesting clarification as to whether or not claims 36-50, 52-57, 71, 73-77 and 84 were being rejected under 35 U.S.C. § 103(a) or whether the rejection was under 35 U.S.C. § 102(b). Examiner Wood indicated to Applicant's representative that the rejections were in fact all rejections made under 35 U.S.C. § 103 and that the text in the Office Action indicated that the rejection under 35 U.S.C. § 102(b) was a typographical error that should be disregarded.

The Office Action rejected claims 36-50, 52-54, 57, 71, 73-75 and 84 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,448,553 to Herr (hereafter the '533 patent) in view of German Patent Document DT 2740189 to Mittlehauser (hereafter DT '189). The Office Action indicated that the '553 patent teaches "...a head() comprising a plurality of foam cores (19, 20, and 21), a mirror (9), a mount (9), a load diffuser (2 and 2), a front and rear shell (10 and 12), an internal chamber (where the from is at the edge of 11 and 23), the stiffness of the diffuser reduces from adjacent said mount." The Office Action

further indicated that the '553 patent teaches all of the limitations of the claimed invention except for the molded thin external plastic body shells. The Office Action stated that DT '189 teaches that it is known to have a front and rear plastic shell having an overlapping butt joint.

Applicant respectfully traverses the rejection of claims 36-50, 52-54, 57, 71, 73-75 and 84 as being rendered obvious by the '553 patent in view of DT '189. In order for a 35 U.S.C. § 103(a) rejection obviousness to be maintained there must be some type of basis or motivation in the reference that makes them properly combinable. Additionally the combination of references will not be proper if the intended function of the references is destroyed. More specifically, Applicant points out that the '553 patent is not properly combinable with DT '189 without destroying the intended function of the '553 patent. Additionally there is no basis in the art for combining these references.

The '553 patent is directed to "...an internal rear view mirror which affords considerable protection from injury when the driver or a passenger is thrown against the mirror in case of an accident." Col. 1, Lines 32-35. Independent claims 36, 41, 46, 57, 71, 73 and 84 of the present invention are all directed to "a vehicle external mirror assembly" as stated in the preamble of each of these independent claims. Nowhere does the '553 patent teach or suggest an external mirror assembly, therefore, there is no motivation to combine the '553 patent with DT '189. Additionally as stated above the intended function of the '553 patent is to provide a padded interior mirror that will protect persons within the vehicle from injury in the event of an accident. See Col. 1, lines 32-35. This intended function (*i.e.*, protecting passengers in the vehicle from injury during an accident) would be destroyed if the teaching of the '553 patent were modified to an exterior mirror application.

In addition to the above arguments regarding whether or not the '553 patent is properly combinable with DT'189, Applicant also wishes to point out that the references when combined will not teach or suggest all of the limitations presented in independent

claims 36, 41 and 46. Neither the '553 patent nor DT '189 teach or suggest a molded external plastic shell. The Office Action indicated that the '553 patent disclosed all the limitations of the claimed invention except for the molded thin external plastic body **shells**. The Office Action further relied upon DT '189 to fill this gap. However, independent claims 36, 41 and 46 only disclose a singular shell and do not describe the shell as containing more than one component. DT '189 only shows a two piece plastic shell and there is nothing that teaches or suggest the use of a one piece plastic shell. Since both the '553 patent and DT '189 patent do not render obvious each and every element of independent claims 36, 41 and 46, the rejection of these claims as well as all of the claims dependent therefrom should be removed.

Claims 36, 40-43, 45-48, 52-54, 57, 73-75 and 84 were rejected under 35 U.S.C. § 103(a) by U.S. Patent No. 6,382,804 to Lang (hereafter the '804 patent) in view of German Patent Document DT 2740189 to Mittlehauser (hereafter DT '189). The Office Action indicated that the '804 patent "...discloses a head (1), a foam core (2), a mirror (7), a mount (Fig. 3), a load diffuser (24), a frame (1)." The Office Action further indicated that the '804 patent taught all of the disclosed limitations of the claimed invention except for the molded thin external plastic body shells. The Office Action relied upon DT '189 to teach that it is known to have "a front and rear plastic shell having an overlapping butt joint (mirror 4, 7, 8, 9, 12 and 21)." Applicant now respectfully traverses the 35 U.S.C. § 103 (a) rejection of the claims as being rendered obvious by the '804 patent in view of DT '189.

With regard to the rejection of claims 36, 40-43, 45 and 73-75 Applicant submits that the rejection of these claims is traverse in light of the amendments to independent claims 36, 41 and 73. Independent claims 36, 41 and 73 have been amended to disclose that the load diffuser is embedded in the foam core. A proposed combination of references must render each and every element of a claim obvious in order for an obvious rejection to be

maintained. The combination of the '804 patent and DT'189 do not render the newly amended claims obvious.

The Office Action specified that the load diffuser is identified on the '804 patent as element or label number 24. The specification of the '804 patent states that "...the housing 1 includes a vertical opening 24 extending through the housing by means of which the housing can be mounted on a tubular arm 25. The housing 1 can be stably bound to the folding arm 25 by screws which are not shown." See '804 patent Col. 3, Lines 45-49. Clearly the above passage from the specification of the '804 patent clarifies that the vertical opening does not by itself diffuse the load but must also include the tubular folding arm 25. The tubular holding arm is not embedded within the foam core, nor does the specification of the '804 patent teach or suggest that the tubular folding arm 25 is embedded within the foam core. Therefore, the '804 patent cannot be relied upon for teaching or suggesting this element of independent claims 36, 41 and 73. Additionally DT'189 does not teach or suggest this limitation.

Claims 36, 41 and 73 also specify that the load diffuser extends from the mount for attaching the mirror to the vehicle. The combination of the '804 patent and DT'189 do not teach or suggest this limitation. The specification of the '804 patent does not specify how the tubular folding arm 25 connects to the vehicle. The drawings also do not show where or if the tubular folding arm 25 connects to the vehicle. Therefore, the '804 patent does not teach or suggest that the tubular folding arm 25 extends from or is connected to the mount that attaches the mirror to the vehicle. The Office Action pointed out that Fig. 3 of the '804 patent shows a mount for attaching the mirror head 1 to a vehicle. However, Applicant points out that the brief description of the drawings indicates that "Fig. 3 is a longitudinal section through a multiple unit mirror according to a second embodiment of the invention." See Col. 2, Lines 42-43. The tubular folding arm 25 and the vertical opening 24 are not part of this embodiment. The Office Action does not specify which particular element is the

mount; however, Applicant notes that label 38 is an anchoring plate that has two side bars 40, 41 that mount onto a support bracket 42 that is part of the vehicle. Col. 4, Lines 11-23. Nowhere does the specification of the '804 patent teach or suggest that loads acting on the mirror head are transmitted through the foam to the load diffuser as specified in independent claims 36, 41 and 73. Applicant notes that DT '189 does not resolve any of the issues discussed above with regard to the '804 patent. DT '189 does not teach or suggest a load diffuser embedded in the foam core, nor does DT '189 teach or suggest that loads acting on the mirror head are transmitted through the foam to the load diffuser. Applicant submits that the combination of the '804 patent and DT '189 together do not render independent claims 36, 41 and 73 obvious since the '804 patent and DT'189 taken together do not teach or suggest all of the limitations of these claims. Additionally, dependent claim 40 which is dependent upon claim 36; dependent claims 42-43 and 45 which depend from independent claim 41; and claims 74-75 which depend from independent claim 73 are all patentable in view of the arguments made above. Therefore, Applicant respectfully requests removal of the rejection of claims 36, 40-43, 45 and 73-75 as being rendered obvious by the '804 patent in view of DT '189.

With respect to the rejection of claims 46-48, 52-54, 57 and 84 as being rendered obvious by the '804 patent in view of the DT '189, Applicant respectfully traverses the rejection of these claims in light of the amendments made to independent claims 46, 57 and 84.

Claims 46, 57 and 84 have been amended to specify that the foam bonds the shells together thereby anchoring and supporting the shells. A proposed combination of references must render each and every element of a claim obvious in order for an obvious rejection to be maintained. The combination of the '804 patent and DT'189 do not render the newly amended claims obvious. The specification of the '804 patent states "[t]he foam core 2 which is preferably a polyurethane substance, is expressed out of an appropriate

molding apparatus, and subsequently the reinforcing layer 3 (also preferably polyurethane) is sprayed thereon. The reinforcing layer 3 congeals into a smooth outer skin of a few millimeters thickness which together with the foam core 2, lends the necessary stability to the housing and makes it weather resistant.” Col. 2, Lines 58-65. Nothing in the ‘804 patent specification or drawings teaches or suggests that the foam core bonds the shell. Therefore, DT’189 must teach or suggest this limitation in order for the references to be combinable to arrive at the claimed invention.

DT ‘189 does not teach or suggest the foam core that bonds the shell. With regard to DT ‘189, it should be noted that the reference is a disclosure that is “added to” the translation of the words “zusatz zu” on the front page of the application. The DT ‘189 published German Patent Application DE 2,732,489 (hereafter the ‘489 reference). This means that the ‘489 reference should also be considered when assessing the teachings of DT ‘189. As stated above claims 46, 57 and 84 have been amended to specify that the foam bonds the shell portion so that it will anchor and support the shells. With respect to DT ‘189 it should be noted that Exhibit A of this response to Office Action contains the German language with the approximate English translation for each of the translations mentioned below. A translation of page 1, paragraph 1, in pertinent part reads “...thereby the base at its inside with projections/leads provides the edge part by bending ductile, which projections/leads of the base exhibits behind-seizing hooks, against to back the edge of the mirror body firmly rests...” Further down on page 2 of DT ‘189 the first full paragraph again states “...whereby the base at its inside provided with projections/leads and the edge part is equipped by bending the ductile projections/leads of the base behind-seizing hooks, again whose back the edge of the mirror body rests firmly.” An examination of the figures of DT ‘189 shows the edge part (5) wrapped around the edge of the base (3) with the mirror (6) abutting against and supporting the edge (5). This is more clearly shown in Figure 3 of the ‘489 reference. The patent teaches that the supporting edge is secured and anchored at

the base by the mirror body firmly resting against it as opposed to foam. Applicant further points out that the butt joint in DT '189 that is shown as encompassing portions of elements 5, 4 and 12 on the figure does not indicate using foam for bonding the front and rear shells as disclosed in claims 46, 57 and 84 of the present application. It is maintained that neither the DT '189 nor the '489 reference teach or suggest using foam to bond the shells together. Since neither the '804 patent in combination with DT '189 or the '489 reference teach or suggest the newly added limitations found in independent claims 46, 57 and 84, Applicant respectfully requests removal of the rejection with respect with these independent claims. Furthermore Applicant requests that claims 47, 48, 52-54 which depend either directly upon or ultimately from independent claim 46 be removed by virtue of their being dependent upon a now allowable base claim. Applicant respectfully submits that the rejection of claims 36, 40-43, 45-48, 52-54, 57, 73-75 and 84 as being rendered obvious by the '804 patent in view of DT '189 has now been overcome by the arguments submitted above. Therefore, Applicant respectfully requests removal of the rejection and allowance of these rejected claims.

The Office Action further rejected claims 37-39, 44, 55, 56, 76 and 77 as being rendered obvious by U.S. Pat. No. 6,382,804 to Lang (hereafter the '804 patent) in view of Mittlehauser DT 2740189 (hereafter DT '189) and further in view of U.S. Patent No. 6,390,634 to Lang (hereafter the '634 patent). The Office Action indicated that the '804 patent in view of DT '189 discloses all of the limitations of the claimed invention except for "...a mount having a pivot assembly receiving portion, a vehicle abutment and connection portion, and a body comprising a second foam core." See Office Action page 4. The Office Action further stated that the '634 patent discloses "...a vehicle external mirror assembly comprising a head (15), a mirror (16), a mount (1 and 2), a foam core (20, Column 4, Lines 2 ff), a load diffuser (6, 7, 8, 5 and 14), a front and rear shell (18 and 19), a second foam core (30), the stiffness of the diffuser reduces from adjacent said mount, the diffuser

changes from two rods (6, 7 and 8) to one rod (14).” The Office Action further stated that “it would have been obvious to have modified Lang in view of Mittlehauser to have provided a mount having a pivot assembly receiving portion, a vehicle body abutment and connection portion, and a body comprising a second foam core as taught by Lang ‘634 for the purpose of provided a more secure anchoring and supporting means that is rigid and durable.” A proposed combination of references must render each and every element of a claim obvious in order for an obvious rejection to be maintained. The combination of the ‘804 patent in view of DT’189 and further in view of the ‘634 patent do not render the newly amended claims obvious.

Applicant now respectfully traverses the rejection of claims 37-39, 44, 55, 56, 76 and 77. Applicant notes that claims 37-39 are dependent claims that depend from independent claim 36; claim 44 is a dependent claim that depends from independent claim 41; claims 55 and 56 are dependent claims that depend from independent claim 46; and claims 76 and 77 are dependent claims that depend from independent claim 73; therefore, since each of these dependent claims incorporate all of the limitations of their respective base claims, independent claims 36, 41, 46 and 73 must be rendered obvious by the ‘804 patent in view of DT ‘189 and further in view of the ‘634 patent. With regard independent claims 36, 41 and 73 Applicant pointed out above that the ‘804 patent in view of DT ‘189 do not render these claims obvious. The reason for this is that independent claims 36, 41 and 73 have been amended to disclose the load diffuser being embedded in the foam core. Applicant pointed out that the ‘804 patent does not teach or suggest this limitation because the tubular arm 25 in the ‘804 patent is not embedded within the foam core but is rather disposed through a vertical opening 24 extending through the housing. DT’189 also does not teach or suggest the load diffuser being embedded in the core. Additionally claims 36, 41 and 73 specify that the load diffuser extends from the mounting for attaching the mirror to the vehicle. The specification of the ‘804 patent does not specify how the tubular folding arm 25



connects to the vehicle, nor is this shown in the drawings of the '804 patent. Likewise, DT'189 does not teach or suggest this limitation.

Applicant also notes that the '634 patent does not resolve any of the above issues with respect to the '804 patent in view of DT '189. The '634 patent describes a tube structure 4 that extends through the mirror assembly 1. See '634 patent Fig. 3. The specification of the '634 patent states that the tubular structure is encapsulated by a foam part 20. See Col. 4, Lines 1-4. The foam part is made of two halves 31, 32 that are sandwiched around the tubular structure 4. See Col. 4, Lines 44-48. Thus the '634 patent fails to teach or suggest the load diffuser being embedded in the core as specified in independent claims 36, 41 and 73. Furthermore, the '634 patent also does not teach or suggest that loads acting on the mirror head are transmitted through the foam to the load diffuser as specified in independent claims 36, 41 and 73. Applicant concludes that claims 36, 41 and 73 will not be rendered obvious by the combination of the '804 patent in view of DT '189 and further in view of the '634 patent. Therefore, the rejection of claims 37, 39, 44, 55, 56, 76, and 77 which are all dependent claims that depend from independent claims 36, 41 and 73 will fall since all of the references cited do not render the underlined base claims obvious. Applicant respectfully requests removal of the rejection and allowance of all the claims presented herein.

#### **Allowable Matter**

Applicant kindly thanks Examiner Wood for indicating that claims 51, 72 and 85 were objected to but would be allowable if rewritten in independent form. Applicant respectfully submits that claims 51, 72 and 85 have been resubmitted as new claim 86 which include all of the subject matter of the dependent claims plus the claims from which they depend. However, Applicant has elected at this time not to cancel claims 51, 72 and 85 since the

underlining base claims are presently being traversed by the Applicant. Applicant also kindly thanks Examiner Wood for allowing claims 58-70 and 78-83.

### CONCLUSION

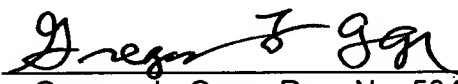
It is respectfully submitted that in view of the above amendments and remarks the claims, as amended, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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Dated: 11/26/04

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## **EXHIBIT A**

### **The '189 Reference**

Page 1, Paragraph 1:

#### **German Language**

Kraftfahrzeugrückblickspiegel mit einem schalen- oder trichterförmigen Gehäuse, in dessen Öffnung der Spiegelkörper angeordnet ist, wobei das Gehäuse einen die Öffnung umschliessenden Randteil aufweist, der für sich hergestellt und an dem übrigen Teile des Gehäuses ( Grundkörper ) befestigt ist, nach Patent ... ( patentanmeldung P 27 32 489.6 ), wobei der Grundkörper an seiner Innenseite mit Vorsprüngen versehen und der Randteil durch Biegen verformbare, die Vorsprünge des Grundkörpers hinterfassende Haken aufweist, an deren Rückseite der Rand des Spiegelkörpers fest anliegt, dadurch gekennzeichnet, dass die freien Enden der Haken (12) mit ihrer Rückseite an einem Widerlager (20) anliegen, das mit dem Grundkörper (3) fest verbunden ist.

#### **English Translation**

Motor vehicle rearview mirror with flat or trichterfoermigen housings, in whose opening of the mirror bodies is arranged, whereby the housing exhibits the opening enclosing edge part, which is fastened for itself manufactured and to remaining parts of the housing (base), after patent... (patent application P 27 32 489,6), whereby the base at its inside with projections/leads provides and the edge part by bending ductile, which projections/leads of the base exhibits behind-seizing hooks, against whose back the edge of the mirror body firmly rests, in the fact characterized that the free ends of the hooks (12) with their back rest against a counter bearing (20), which is firmly connected with the base (3).

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#### **German Language**

Zusatz zu Patent ..... ( Patentanmeldung P 27 32 489.6 )

Die Erfindung betrifft einen Kraftfahrzeugrückblickspiegel mit einem schalen- oder trichterförmigen Gehäuse, in dessen Öffnung der Spiegelkörper angeordnet ist, wobei das Gehäuse einen die Öffnung umschliessenden Randteil aufweist, der für sich hergestellt und an dem übrigen Teil des Gehäuses ( Grundkörper ) befestigt ist, nach Patent .... (Patentanmeldung P 27 32 489.6 ), wobei der Grundkörper an seiner Innenseite mit Vorsprüngen versehen und der Randteil durch Biegen verformbare die Vorsprünge des Grundkörpers hinterfassenden Haken ausgestattet ist, an deren Rückseite der Rand des Spiegelkörpers fest anliegt.

#### **English Translation**

Additive to patent..... (patent application P 27 32 489,6)

The invention concerns a motor vehicle rearview mirror with flat or trichterfoermigen housings, in whose opening of the mirror bodies is arranged, whereby the housing exhibits the opening enclosing edge part, which is fastened for itself manufactured and to the remaining part of the housing (base), after patent.... (patent application P 27 32 489,6), whereby the base at its inside provided with projections/leads and the edge part is equipped by bending the ductile projections/leads of the base behind-seizing hook, against whose back the edge of the mirror body rests firmly.